

REMARKS

The Office Action and the cited and applied references have been carefully reviewed. No claim is allowed. Claims 1-20 presently appear in this application and define patentable subject matter warranting their allowance. Reconsideration and allowance are hereby respectfully solicited.

Claims 1-14 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. This rejection is partly obviated by the amendments to the claims. The claims are amended so that it is clear that they are method of use claims and not compound (product) claims. However, with regard to the recitation of "sulfonyl" in claim 1, this term is clearly defined at page 9, lines 5-10, of the present specification, and therefore "sulfonyl", as recited in the claims, is not indefinite.

Reconsideration and withdrawal of the rejection are therefore respectfully requested.

Claims 1-8, 11, 12 and 14 have been rejected under 35 U.S.C. §102(b) as being anticipated by Halazy et al., WO 01/47920. This rejection is respectfully traversed.

The instant claims are amended to be clearly directed to a method for treating a metabolic disorder mediated by insulin resistance or hyperglycemia, such as inadequate glucose tolerance, insulin resistance, diabetes type II. By contrast,

Halazy discloses the therapeutic applications to be treated by Halazy's disclosed benzazole compounds on page 25, lines 3-9, none of which is a metabolic disorder mediated by insulin resistance or hyperglycemia, as presently recited in the instant claims. Accordingly, Halazy cannot anticipate the presently claimed invention.

Reconsideration and withdrawal of the rejection are therefore respectfully requested.

Claims 1-8, 11 and 12 have been rejected under 35 U.S.C. §102(b) as being anticipated by Gaillard et al., WO 03/091249. This rejection is respectfully traversed.

Gaillard discloses at page 15 that Gaillard's benzothiazole compound can be used in the treatment of cerebral ischemic disorders or CNS disorders, but there is no disclosure or teaching of using such compounds to treat metabolic disorders mediated by insulin resistance or hyperglycemia as presently claimed. Accordingly, Gaillard cannot anticipate the presently claimed invention.

Reconsideration and withdrawal are therefore respectfully requested.

Claim 1-14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Halazy et al., WO 01/47920. This rejection is respectfully traversed.

For the same reason above that Halazy cannot anticipate the presently claimed invention, Halazy also cannot lead one of ordinary skill in the art to the presently claimed invention. It would certainly not be obvious to one of ordinary skill in the art that metabolic disorders mediated by insulin resistance or hyperglycemia can be treated with the benzazole compounds based on their use against other specifically identified indications that are distinctly unrelated to metabolic disorders mediated by insulin resistance or hyperglycemia.

Reconsideration and withdrawal of this rejection are therefore respectfully requested.

Claims 1-8, 11 and 12 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Gaillard et al., WO 03/091249. This rejection is respectfully traversed.

For the same reason above that Gaillard cannot anticipate the presently claimed invention, Gaillard also cannot lead one of ordinary skill in the art to the presently claimed invention. It would certainly not be obvious to one of ordinary skill in the art that metabolic disorders mediated by insulin resistance or hyperglycemia can be treated with benzothiazole compounds based on their use against cerebral ischemic disorders or CNS disorders that are distinctly unrelated to metabolic disorders mediated by insulin resistance or hyperglycemia.

Reconsideration and withdrawal of this rejection are therefore respectfully requested.

Claims 1-8, 11, 12 and 14 have been rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-7 and 9 of US Patent 7,314,878. This rejection is respectfully traversed.

The present claims are not directed to a benzothiazole compound but rather to a method of use. Only claim 8 of US'878 is directed to a method of use in which a pharmaceutical composition containing the compound is administered for treating ischemia. As argued above, the presently claimed method for treating metabolic disorders mediated by insulin resistance or hyperglycemia is not obvious over a method for treating ischemia, a distinctly unrelated indication.

Reconsideration and withdrawal of this rejection are therefore respectfully requested.

Claims 1-8, 11, 12 and 14 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of US Patent 7,259,162. This rejection is respectfully traversed.

Claims 1-5 of US'162 are compound claims. As there are no method of use claims in US'162, there is no obviousness-type double patenting between the instant method of use claims and the claims of US'162.

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Reconsideration and withdrawal of the rejection are
therefore respectfully requested.

In view of the above, the claims comply with 35 U.S.C.
§112 and define patentable subject matter warranting their
allowance. Favorable consideration and early allowance are
earnestly urged.

Respectfully submitted,

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